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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,990	09/17/2003	Nobukatsu Hara	SN-US035123	1968

22919 7590 12/29/2004

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EXAMINER

DEPUMPO, DANIEL G

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p align="center">10/663,990</p>	<p>Applicant(s)</p> <p align="center">HARA ET AL. ST</p>	
	<p>Examiner</p> <p align="center">Daniel G. DePumpo</p>	<p>Art Unit</p> <p align="center">3611</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 5,13,15,19,21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12,14,16-18,20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/17/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election without traverse of Group I and species B (claims 1-4, 6-12, 15-18 and 20-22 allegedly readable thereon) in the reply filed on 11/1/04 is acknowledged. It is noted that claim 21 depends from non-elected claim 13. Consequently, claim 21 is also withdrawn from further consideration.

Claims 5, 13, 14, 19, 21 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

2. Claims 1-4, 6-12, 15-18, 20 and 22 are objected to because of the following informalities: In claim 1, line 2, it appears that "dimension" should be --dimensioned--. Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-4, 6, 7 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites that the fixing portion is configured to "secure the cap portion *within* a steering tube of a bicycle fork" (emphasis added). This appears to be incorrect because the cap portion is outside of the steering tube, and not "within" the steering tube. Clarification and/or correction are required.

Claim 22 recites a cap portion having an electrical part receiving space. This is incorrect, because the receiving space is in the housing portion, not the cap portion. Also, in line 7, "the housing portion" lacks antecedent basis.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 7, 8, 10-12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuji.

Tsuji teaches a head cap unit having the structure as claimed. The device includes a cap portion 38, a housing portion 27, a fixing portion 42/44 and electrical connectors (57, and where wire 54 joins element 49). Element 49 is considered to comprise a control unit as broadly claimed. Since Tsuji discloses the structure as claimed, the device is inherently capable of

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functioning as claimed. It is noted that the extensive function recitations (e.g. dimension[ed] to, configured to, etc.) do not provide structure that defines over Tsuji.

7. Claims 1-4, 7-10, 12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson.

Peterson teaches a device having the structure as claimed. The device includes a cap portion 42, a housing portion (22/23 and 40), a fixing portion 82/84/86 and various electrical connectors (including the batteries and associated contacts). The batteries are considered to comprise a control unit as broadly claimed. Since Peterson discloses the structure as claimed, the device is inherently capable of functioning as claimed. It is noted that the extensive function recitations (e.g. dimension[ed] to, configured to, etc.) do not provide structure that defines over Peterson.

8. Claims 1-4, 6 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Campagnolo '575.

Campagnolo teaches a device having the structure as claimed. The device includes a cap portion 13, a housing portion 5, a fixing portion 14/15 and a tubular part (the unlabeled element that connects the washers 14, as depicted in fig. 1). Since Campagnolo discloses the structure as claimed, the device is inherently capable of functioning as claimed. It is noted that the extensive function recitations (e.g. dimension[ed] to, configured to, etc.) do not provide structure that defines over Campagnolo.

9. Claims 1-4, 6, 8, 9, 10, 12, 15-18, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimano '983.

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Shimano teaches a device having the structure as claimed. The device includes a cap portion 11, a housing portion 1/2, a fixing portion (either the threads on element 11, or elements 13 and 14) and a battery 53. The various electrical components (including element 52) are considered to comprise a control unit as broadly claimed. Since Shimano discloses the structure as claimed, the device is inherently capable of functioning as claimed. It is noted that the extensive function recitations (e.g. dimension[ed] to, configured to, etc.) do not provide structure that defines over Shimano.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kinoshita and Schmider disclose various devices having features in common with the instant invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is 703 308-1113. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703 308 1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel G. DePumpo
Primary Examiner
Art Unit 3611

dgd
12/27/04